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09/664,247	09/18/2000	Wilhelm Elsner	2384/001440	4085

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EXAMINER

MCCORMICK, SUSAN B

ART UNIT

PAPER NUMBER

1661

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18

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/664,247
Filing Date: September 18, 2000
Appellant(s): ELSNER, WILHELM

Russell D. Orkin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 13, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

There is only a single claim.

(8) Claims Appealed

There is only a single claim and that claim is appealed.

(9) Prior Art of Record

Application for community protection of plant varieties, Community Plant Variety Office, European Union. Application 970950, filed 9/3/97 and published 12/15/97 (hereinafter referred to as "QZ PBR 970950").

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b).

Claim 1 (the claim) is rejected under 35 U.S.C. 102(b) as the instant plant 'Pendec' was described in the following printed publication more than one year prior to the date of application for Plant Patent (September 18, 2000) in the United States:

(1) QZ PBR 970950, filed on September 3, 1997 and published on December 15, 1997.

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The grounds of rejection are set forth in paper no. 13, pages 2-3.

(11) Response to Argument

Appellant's Reply Brief (paper no. 14) introduces new evidence and raises two new points of argument. In the interest of fully developing the issue at hand and placing the question before the Board of Appeals as expeditiously as possible, the examiner has chosen to reopen prosecution. The Examiner adheres to all of the positions set forth in the Examiner's Answer (paper no. 13, pages 3-13). This supplemental Examiner's Answer is limited to discussion of the new arguments presented in the Reply Brief.

Appellant argues that, pursuant to Article 87(1) of Council Regulations (EC) No. 2100/94, only the names of the breeder and his representative, the taxon statement (i.e. the species of plant) and provisional denomination were available for public inspection (Reply Brief, p. 2). It is unclear how Appellant arrived at this conclusion.

Article 87 states, in part:

Article 87

Establishment of the Registers

1. The Office shall keep a Register of Applications for Community Plant Variety Rights which shall contain the following particulars:

(a) applications for a Community plant variety right *together with* a statement of the taxon and the provisional designation of the variety, the date of application and the name and address of the applicant, of the breeder and of any procedural representative concerned; [emphasis added]

Article 88 states, in part:

Article 88

Public inspection

1. The Registers mentioned in Article 87 shall be open to public inspection.

Thus it appears that the items listed by Appellant are kept in the Register "together with" the application.

In any event, both Examiner and Appellant are in agreement that adding additional botanical description to the publicly available application information would not "enable" the printed words therein. The published application is an enabling disclosure by virtue of the public availability of the plant itself, which is required to make (asexually reproduce) the plant. No matter how much descriptive information was available to the public, the fact remains that the plant was in the public domain and the public was notified of this fact. Anyone interested in new geranium varieties, such as a nurseryman seeking new varieties to grow for retail sale, could have used the available information to contact the plant breeder and arrange to purchase the plant. With the plant in hand, it would not require any further exercise of inventive skill to asexually reproduce it by cuttings or other means known to one skilled in the art.

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Appellant argues that the *LeGrice* court had evidence of commercial sale of the claimed plants (Reply Brief, pp. 3-5). This argument is not persuasive. Contrary to Appellant's assertion, the facts in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states, "The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record..." 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere.

Appellant argues that the *LeGrice* Board of Appeals disposed of the issue of public sale enabling a printed publication. This argument is not persuasive because the Board ruled that the printed publications alone (i.e. without evidence of public availability of the claimed plants) warranted a rejection under 35 U.S.C. 102(b). The question of whether public availability of the plants would "enable" the publications was not considered by the Board or the CCPA.

Moreover, Applicant *LeGrice* never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Reply Brief, attachment, p. 22, "The catalogues have not been made available"). How could the Board or the CCPA have known the contents of publications that were never part of the record? It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the Applicant did not comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection (Reply Brief, attachment, p. 22, last paragraph). The fact that *LeGrice* was listed as "distributor" does not in itself indicate that the claimed plants had already been distributed to the public, nor would mere display at an exhibition put the public in possession of the claimed plants. In *Ex parte Thomson*, the Board of Appeals concluded that the *LeGrice* case did not have in evidence facts supporting commercial availability of the claimed plants (24 USPQ2d 1618, 1621).

For the above reasons, it is believed that the rejection should be sustained.

The Supervisory Patent Examiner requests the opportunity to present arguments at the oral hearing.

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Respectfully submitted,

Susan B. McCormick
Examiner
Art Unit 1661

Susan B. McCormick
March 13, 2003

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